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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BOVEJA, NAMRATA	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,575	NEWNAM ET AL.	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 April 2002 & 16 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 05/02/2006.

2. Claims 1-22 are presented for examination.

3. Amendments to claims 1, 4, 7, 8, 11, 14, 17, 18, and have been entered and considered.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention. There are two separate requirements set forth in this paragraph:
> (A) the claims must set forth the subject matter that applicants regard as their invention; and
> (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

4. Claim 19 is rejected under 35 U.S.C. 112.

Claim 19 recites, "**the method, the server system**", and it is unclear if this claim pertains to the **method or the server system**. Since the remainder of the claim pertains to the **server system**, it is interpreted that the entire claim pertains to the **server system** and not to a **method**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-3, 6, 8, 10-14, 17-19, and 22 are rejected under 102(a) as being anticipated by Shoff et al. (Publication Number US 2001/0001160 A1 hereinafter Shoff).

In reference to claim 1, *Shoff* discloses a method for enhancing a broadcast event comprising: providing content *from a server system to remote users (page 3 paragraph 35 and Figure 2), the content* related to the broadcast event *(page 4 paragraphs 48-50), the* remote users having local devices that can *store* content *(page 4 paragraph 51 and page 5 paragraph 55)*; and during the broadcast event, the server system providing to the local devices messages that *identify the content and* cause the local devices to display the *stored* content *locally (page 4 paragraph 51)*; wherein the content and *the* messages *identifying the content* are *both* provided to at least two different types of local devices, including personal computers *(page 4 paragraph 46 and Figure 4)*, set top boxes *(page 2 paragraph 29 and Figure 2)*, net top boxes, *and* consoles, *the method further comprising providing to users different base software for displaying content depending on the type of local device (i.e. different software is used to layout the content for a television screen versus a computer screen) (page 2 paragraph 18 and 19, page 3 paragraph 37, page 6 paragraphs 68 and 76, and Figures 7, 8b, and 8c).*

6. In reference to claim 2, *Shoff* discloses a method wherein the content and messages are sent via Internet Protocol *(abstract, page 1 paragraph 10, page 2 paragraph 17, page 4 paragraphs 49 and 52, and Figures 2, 3, and 5).*

7. In reference to claim 3, *Shoff* discloses a method further comprising, in response to an advertisement being broadcast, the server system selecting one additional

advertisement from a plurality of different advertisements tailored to different users, the one advertisement being related to, and for display at the same time as, the broadcast advertisement *(page 2 paragraph 17, page 3 paragraph 40, page 4 paragraph 49, and Figures 3 and 8c).*

8. In reference to claim 6, *Shoff* discloses a method wherein the broadcast event is broadcast over television, radio, and/or the Internet *(page 1 paragraphs 2, 6, and 8, page 2 paragraphs 28-29, and Figure 2).*

9. In reference to claim 8, *Shoff* discloses a method further comprising transmitting the interactive content before the broadcast event begins *(i.e. the interactive content can be supplied separately and it can be provided beforehand on a CD) (page 2 paragraph 17, page 4 paragraphs 50 and 51, and page 5 paragraph 66).*

10. In reference to claim 10, *Shoff* discloses a method wherein the messages do not include Internet addresses but are sent at the same time as Internet addresses that are used for accessing web pages with similar content, the local devices displaying content in response to the messages and not using the Internet addresses on receiving a message *(i.e. URL's are embedded within text-based data or they can be sent separately from the broadcast content) (page 2 paragraph 17, page 4 paragraphs 44 and 49-51, page 5 paragraph 66, and Figure 3).*

11. In reference to claim 11, *Shoff* discloses a method wherein at least two of the different types of local devices are programmed to display interactive content in a manner different from each other in terms of location of content on a display *(page 6 paragraph 68-69 and 76, page 7 paragraph 78, and Figures 2, 4, 7, 8a, 8b, and 8c).*

12. In reference to claim 12, *Shoff* discloses a method wherein the broadcast content is displayed and the broadcast content and the interactive content are provided on the same display in different windows *(i.e. panes, screens, or pop-ups) (page 1 paragraph 10, page 6 paragraphs 68 and 76, page 7 paragraph 78, and Figures 1, 7, 8a, 8b, and 8c).*

13. In reference to claim 13, *Shoff* discloses a method wherein the broadcast content is displayed and the broadcast content and the interactive content are provided on the separate displays *(i.e. on a television screen and a computer screen) (page 2 paragraphs 15-18 and Figures 2 and 4).*

14. In reference to claim 14, *Shoff* discloses a method wherein the interactive content includes content applicable to multiple *episodes of a* broadcast event for display during *each of the episodes (i.e. advertisements associated with Star Trek or Seinfeld in general) (page 3 paragraph 40 and Figure 3)*, and *other* content *that is* applicable to specific *episodes* for display during the respective specific *episodes (i.e. surveys associated with that particular broadcast)(page 6 paragraph 76).*

15. In reference to claim 17, *Shoff* discloses a method wherein the server system determines the type of local device and provides *the base software* in response to that determination *including a configuration file for interpreting messages (i.e. different software is used to layout the content for a television screen versus a computer screen) (page 2 paragraph 18 and 19, page 3 paragraph 37, page 6 paragraphs 68 and 76, and Figures 7, 8b, and 8c).*

16. In reference to claim 18, *Shoff* discloses a method wherein a first type of local device is programmed to use the content from the server system in one manner and a second type of local device is programmed to use the content from the server system in another *and different* manner *(i.e. can be used to toggle between contents by use of buttons, can be used to invoke a pop up box, can be used to see a URL on a computer screen linking to a website, and can be used to view data on a disc in the disc drive when instructed to do so by the server) (page 3 paragraphs 40-43, page 4 paragraph 51, and page 6 paragraph 70-76)*

17. **Disclaimer:** Claim 19 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 19, *Shoff* discloses the server system for maintaining multiple local advertisement messages directed toward different users or groups of users *(i.e. a group of users can be formed on the basis of the particular program the users view)*, the server system responsive to an advertisement being broadcast with the broadcast event, for selecting one of a plurality of the local advertisements and for causing that advertisement to be displayed additionally to the user at the same time as

the advertisement in the broadcast event *(page 3 paragraphs 40 to page 4 paragraph 43, page 4 paragraphs 49 and 51, and Figures 3 and 4).*

18. In reference to claim 22, *Shoff* discloses the *method* wherein the selected local advertisement is provided to a computer *(page 2 paragraphs 15,16, and 29, page 4 paragraph 51, and Figure 4) and the broadcast event is provided to a television (page 1 paragraph 2, page 2 paragraphs 15,16, and 29, and Figures 1 and 2).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 4, 5, 20, and 21 are rejected under U.S.C. 103(a) as being unpatentable over *Shoff* in view of Stewart et al (6,414,635 hereinafter Stewart).

In reference to claims 4 and 21, *Shoff* does not teach the method further comprising *the server system* maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles. Stewart teaches the method further comprising maintaining user profiles, wherein the server system selects the one additional local advertisement based on the user profiles (col. 10 lines 8-20 and col. 13 lines 36-54). It would have been obvious to modify *Shoff* to include maintaining user profiles, wherein the server system selects the one additional

local advertisement based on the user profiles to better target advertisements to users based on user preferences.

20. In reference to claims 5 and 20, *Shoff* does not teach the method wherein the server system selects the one additional local advertisement based on the user's location. Stewart teaches the method wherein the server system selects the one additional local advertisement based on the user's location (col. 5 lines 18-24 and col. 13 lines 36-54). It would have been obvious to modify *Shoff* to include the server system selecting the one additional local advertisement based on the user's location to deliver better targeted advertisements to users based on whether the user is at home, hotel, or a gym for example that will be more relevant to the user based on the user's location at the time of the broadcast.

21. Claims 7 and 9 are rejected under U.S.C. 103(a) as being unpatentable over *Shoff* in view of Barton et al (6,233,389 hereinafter Barton).

In reference to claims 7 and 9, *Shoff* teaches the method further comprising transmitting the interactive content to the local device while the event is occurring *(page 2 paragraphs 16 and 17 and page 4 paragraph 50). Shoff* does not teach storing and downloading this content for later display in response to a message after the content has been transmitted. Barton teaches storing and downloading this content for later display in response to a message after the content has been transmitted by using a multimedia time warping system, also known as TIVO (abstract, col. 1 lines 63 to col. 2 lines 3, col. 3 lines 19-29, and Figure 1). It would have been obvious to modify *Shoff* to include a system that can store content for later display in response to a message after

the content has been transmitted to enable the user to view the content at a time that is convenient for the user and not dictated by the time of the original broadcast.

22. *Claim 15 is* rejected under U.S.C. 103(a) as being unpatentable over *Shoff* in view of Barton et al (6,233,389 hereinafter Barton) and further in view of Official Notice.

In reference to claim 15, *Shoff* does not teach the method wherein at least some of the local devices include a recording device for receiving and storing the broadcast event, the content, and the messages and associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast. Barton teaches the method wherein at least some of the local devices include a recording device for receiving and storing the broadcast event, the content, and the messages (abstract, col. 1 lines 63 to col. 2 lines 3, col. 3 lines 19-29, and Figure 1). Barton is silent about associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast. Official notice is taken that is well known to present interactive content in a playback environment such as when a user plays a game in a playback mode and the user does not get to find out the answers to the game questions until the end of the game. Additionally, it is well known that if the broadcast includes an associated URL, the URL will be retrieved accordingly at that time in a re-broadcast of the original event. It would have been obvious to modify *Shoff* to include a method wherein at least some of the local devices include a recording device for

receiving and storing the broadcast event, the content, and the messages and associating the timing of the content messages with the programming such that the playback of the broadcast event from the recording device includes the content and messages being provided at the same relative time as during the broadcast to enable users to view the content at a convenient time without losing the feel of the real-time interactive nature of the invention.

23. *Claim 16 is rejected under U.S.C. 103(a) as being unpatentable over Shoff in view of Official Notice.*

In reference to claim 16, *Shoff* does not teach the method wherein the server system is responsive to a user entering data in response to content displayed during playback of a broadcast event for providing follow-on content related to the user entering data. Official notice is taken that it is well known for interactive playback storage devices to present follow-on content in response to a user entering data during a playback of a broadcast event as done when a user is presented a survey to complete and will receive the follow on content of survey results only after the user completes the survey in the playback environment. It would have been obvious to modify *Shoff* to include the method wherein the server system is responsive to a user entering data in response to content displayed during playback of a broadcast event for providing follow-on content related to the user entering data to maintain the interactive and real-time feel of a previously broadcasted program for the user and to maintain the surprise of aggregate results until the user has provided his/her input by completing the survey.

Response to Arguments

24. After careful review of Applicant's remarks/arguments filed on 05/02/2006, the Applicant's arguments with respect to claims 1-22 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

25. The previously made 112 Rejections are being removed, since the Applicant's amendments to the claims sufficiently addresses the issues previously raised by the Examiner in this case. However, Applicant's amendment to claim 19 introduces a new 112 Rejection, since it recites, "the method, the server system", and it is unclear if this claim pertains to the method or the server system. Since the remainder of the claim pertains to the server system, it is interpreted that the entire claim pertains to the server system and not to a method.

26. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

July 27th, 2006

RETTA YEHDEGA
PRIMARY EXAMINER